

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JON E. FREACH,
ROBERT MOORE, KENNETH A. FUIKS and KEVIN D. DAVIS

Appeal No. 2002-0883
Application No. 08/759,899

ORDER REMANDING TO EXAMINER

Before STONER, Chief Administrative Patent Judge; HARKCOM,
Vice Chief Administrative Patent Judge; and WILLIAM F. SMITH,
Administrative Patent Judge.

PER CURIAM

The Office of the Deputy Commissioner for Patent
Examination Policy has requested that this application be

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remanded to the jurisdiction of the patent examiner so that issues raised in this appeal can be reconsidered. Accordingly, we remand.

A. Findings of Fact:

On November 9, 1998, appellants filed a Notice of Appeal (Paper No. 10) and on June 21, 1999¹ filed an Appeal Brief (Paper No. 11). On August 2, 1999, the examiner mailed an Examiner's Answer (Paper No. 12). Appellants filed a Reply Brief on October 18, 1999 (Paper No. 15). On December 6, 1999, the examiner mailed an Office communication (Paper No. 116) which included a rebuttal of the position set forth in the Reply Brief.

On December 1, 1997, the rule pertaining to the Examiner's Answer and Reply Brief, 37 CFR § 1.193, was amended to read as follows:

§ 1.193 Examiner's answer and reply brief.

. . .

(b)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of such examiner's answer. . . . The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief.

¹ Certificate of mailing dated January 7, 1999.

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A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.

Thus, the examiner's response was inappropriate.

B. Conclusion

In view of the changes to 37 CFR § 1.193(b)(1), the entry of the examiner's Office communication mailed December 6, 1999 (Paper No. 16), is inappropriate.

Apprised of these problems, the Office of the Deputy Commissioner for Patent Examination Policy has requested this remand.

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The Board must be informed promptly of any action affecting the appeal in this case, including reopening of prosecution, allowance and/or abandonment of the application.

REMAND

BRUCE H. STONER, JR.)	
Chief Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
GARY V. HARKCOM)	
Vice Chief Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
WILLIAM F. SMITH)	
Administrative Patent Judge)	

BHS:ds

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